

REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action.

OBJECTION TO SPECIFICATION

The specification was objected to as failing to provide proper antecedent basis for “a surface” as used in claim 1. The specification has been amended appropriately herein to obviate the objection.

OBVIOUSNESS

JP ‘285 in view of Kinugawa ‘309

Claims 1, 4, 9 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over JP4-13285 (hereinafter “JP ‘285”) in view of U.S. Patent Application Publication No. 2004/0079309 to Kinugawa (hereinafter “Kinugawa ‘309”). For the following reasons, the rejection is now respectfully traversed.

As the Office action acknowledges, JP ‘285 does not disclose “the first positioning member retracted within the surface of the first member so that the first positioning member is held at a position where no portion of the first positioning member protrudes” as required. Thus, Kinugawa ‘309 is relied upon to disclose this limitation. The Office action states that it would have been obvious to modify JP ‘285 based on Kinugawa ‘309 because it would yield predictable benefits. Applicants respectfully disagree.

Applicants respectfully submit that the teachings of Kinugawa ‘309 are non-analogous to those of JP ‘285, and thus the combination of these references is not proper. The Office action cites the lock pin (91) of Kinugawa ‘309 as the first positioning member as set forth in claim 1. While the lock pin (91) itself is indeed mechanically similar to the claimed positioning member, it is used in a substantially different environment and has a substantially different function than that of JP ‘285. Like the claimed invention, JP ‘285 relates to a robotic arm having two members connected by a rotating joint. In a different unrelated field, the teachings of Kinugawa ‘309 relate to a valve timing adjusting apparatus for an internal combustion engine. As disclosed by Kinugawa ‘309, the lock pin (91) is provided for preventing rotation between a case (70) and a rotor (80) during starting and stopping of the engine. As set forth in MPEP § 2131.01(a), I: “a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole.” Applicants fail to see how a lock pin for immobilizing a rotor in an engine during startup/shutdown *logically would have commended itself to an inventor's attention* in designing a positioning member for performing an origin adjustment of an industrial robot. Accordingly, Applicants respectfully submit that no *prima facie* case of obviousness can be established for purposes of maintaining a rejection under 35 U.S.C. 103(a) and the rejection should be withdrawn.

JP '285 in view of Miyasaka

Claims 1, 4, 9 and 10 were further rejected under 35 U.S.C. 103(a) as being unpatentable over JP4-13285 (hereinafter “JP ‘285”) in view of U.S. Patent No. 6,394,052 to Miyasaka et al. (hereinafter “Miyasaka”). For the following reasons, the rejection is now respectfully traversed.

As the Office action acknowledges, JP ‘285 does not disclose “the first positioning member retracted within the surface of the first member so that the first positioning member is held at a position where no portion of the first positioning member protrudes” as required. Thus, Miyasaka is relied upon to disclose this limitation. The Office action states that it would have been obvious to modify JP ‘285 based on Miyasaka because it would yield predictable benefits. Applicants respectfully disagree.

Applicants respectfully submit that the teachings of Miyasaka are non-analogous to those of JP ‘285, and thus the combination of these references is not proper. The Office action cites the locking pin (37) of Miyasaka as the first positioning member as set forth in claim 1. While the locking pin (37) itself is indeed mechanically similar to the claimed positioning member, it is used in a substantially different environment and has a substantially different function than that of JP ‘285. Like the claimed invention, JP ‘285 relates to a robotic arm having two members connected by a rotating joint. In a different unrelated field, the teachings of Miyasaka relate to a valve timing adjusting apparatus for an internal combustion engine. As disclosed by Miyasaka, the locking pin (37) is provided for preventing rotation between a housing member (4) and a vane rotor (15) during the operation of the device. Applicants fail to see how a lock pin for immobilizing a rotor in a variable timing device for an internal combustion engine *logically would have commended itself to an inventor’s attention* in designing a positioning member for

Appl. No. 10/536,594
Response Dated March 9, 2010
Reply to Office action of December 9, 2009

performing an origin adjustment of an industrial robot. Accordingly, Applicants respectfully submit that no *prima facie* case of obviousness can be established for purposes of maintaining a rejection under 35 U.S.C. 103(a) and the rejection should be withdrawn.

CONCLUSION

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No.: NGB-38313.

Respectfully submitted,

PEARNE & GORDON LLP

By: /Aaron A. Fishman/
Aaron A. Fishman, Reg. No. 44682

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

Date: March 9, 2010